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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,641	07/20/2001	Perriann M. Holden	1827-U-01 CIP	2605

33651 7590 10/29/2002

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EXAMINER

HOEY, ALISSA L

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/910,641	HOLDEN, PERRIANN M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alissa L. Hoey	3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,5,9 and 10 is/are allowed.
- 6) ☒ Claim(s) 1-3,7-8 and 12-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 6 and 11 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Group A, claims 1-5 and 7-10 and 29-33 are drawn to a protective pad and group B, claims 6 and 11 are drawn to a protective shell.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Jerry Potts on 10-21-02 a provisional election was made without traverse to prosecute the invention of group A, claims 1-5 and 7-10 and 12-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6 and 11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 7, 21-24 and 29-33 rejected under 35 U.S.C. 102(b) as being anticipated by Decorative Band-aid 1956 (Johnson & Johnson Companies, Inc. 2001-2002).

Decorative Band-aid provides a novelty fashion wear item comprising a flexible pad having an upper surface and a lower surface with a non-slip texture. The pad being sufficiently flexible to conform to a contoured surface area of a body part. The pad having it's upper surface coated with a non skin irritating adhesive material for removable securing the pad to the contoured surface area of a body part to facilitate decorating the contoured surface area. The pad having it's lower surface provided with indicia to decorate the contoured surface area. A peelable material covering the non-

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skin irritating adhesive to protect the adhesive material until it is ready for use to facilitating decorating a contoured area of a user's selected body part. The non-slip pad is sufficient thickness to protect the contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface. The pad is flexible to conform to the contour of user selected body parts consisting of hands, fingers, feet toes, knees and elbows. The non-slip pad is trimmable and disposable and is made from synthetic materials. The decorative indicia is selected from colors and patterns. Further, Decorative Band-aid provides the method of decorating providing a pad of decorative fashion wear adapted to conform to the contour of a selected body part and removably applying the pad of decorative fashion wear to a selected body part to facilitate decorating the selected body part with decorative indicia. Providing a peelable film to cover and preserve the reusable adhesive material until used. The step of providing the lower surface with indicia includes selecting the indicia from colors or patterns, peeling the film from the adhesive and applying the pad to the selected body part (see Band-aid 1956 Johnson & Johnson Companies, Inc. 2001-2002).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 8, 12-20 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decorative Band-aid.

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Decorative Band-aid provides a fashion pad as described above in claims 21, 22 and 23. However, Decorative Band-aid fails to teach trimming the pad to a desired shape, the fashion pad being a shoe, glove or elbow pad, the thickness of the pad and the material.

It would have been obvious to have provided the Decorative Band-aid trimmable to any shape, having any thickness, made out of any material and taking any form as desired for end use. Size, material and shape are limitations that can be determined by one having ordinary skill in the art based upon desired end use.

***Allowable Subject Matter***

7. Claims 4, 5, 9 and 10 are allowed.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Printed Bandages (<http://www.promobrand.com>) is cited to show closely related fashion pads.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (703) 308-6094. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 305-1025. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0758 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

alh  
October 21, 2002

  
JOHN D. CALVERT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700